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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,857	04/13/2004	Qingping Zhuan	12230-3	2662
1059	7590	10/19/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			COLE, LAURA C	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,857

Applicant(s)

ZHUAN, QINGPING

Examiner

Laura C Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07222004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9 and 10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11 and 12 of prior U.S. Patent No. 6721986. This is a double patenting rejection.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No.

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6721986. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure required by Claim 1 of the instant application is found verbatim in Claim 1 of USPN 6721986. Claim 1 of USPN 6721986 further includes a portion of the structure of Claim 2 of the instant application. The subject matter found in Claims 1 and 2 of the instant application is found wholly Claims 1 and 2 of USPN 6721986. It would have been obvious for one of ordinary skill in the art at the time the invention was made to recognize that claim 1 in the instant application covers not only the same, but a greater scope than Claim 1 of the patent

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ullrich, DE 3544256.

Ullrich displays an electric toothbrush comprising a housing (Figure 1), an electric motor (15) having a motor output member for rotation about a motor output axis (16), a first transmission to convert rotational movement into rotational reciprocating movement at a first angular speed or sweep (first transmission includes gears (17) and (18), and crank element (19) that slides in the gap (20) to provide reciprocating movement), and a second transmission linked to the first transmission (linked by (22)) to convert the rotational reciprocating movement of the first transmission into a rotational reciprocating

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movement at a second average angular speed or sweep about a second transmission output axis that is parallel to the motor output axis (Figure 1) and to drive an output member being a brush head (Figure 1) to reciprocate at a second average angular speed or sweep about a second transmission output axis (second transmission includes gears (27), (28), (23), and (24) which would have the second average angular speed or sweep about the second transmission output axis different than the first average angular speed or sweep seeing how the gear train of the second transmission inherently changes the speed of the first transmission). The motor output member comprises a first gear (17) and the first transmission comprises a rotatable second gear which mates with the first gear member (18, with axis y), an orbiting member attached to the second gear to convert rotation of the second gear to orbital movement (19), and a rotatable slotted member slidably connected to the orbiting member to convert the orbital movement into rotational reciprocating movement a first average angular speed or sweep (slotted member (21) has slot (20)). The brush head output member (3) has an axis angled relative to the second transmission output axis (it is angled 180°). It appears from Figure 1 that the second average angular speed and sweep (taken at (27) or (23)) is greater than the first average angular speed and sweep (the speed of (19) upon gear (18)) since the Applicant discloses in Paragraph 17 of the Specification that the second average angular speed and sweep are larger than the first average angular speed and sweep in *inverse proportion* to the ratio of their radii. Ullrich, DE 3544256 does not disclose a section of internal gear connected to the first transmission.

Conclusion

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4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,353,460 to Bauman discloses a power driven toothbrush with a transmission, electric motor, housing, a section of internal gear (20) with a gear drivenly connected to section(s) of the internal gear for rotational reciprocating movement (see Figures 3-4) along a second angular sweep about a gear member axis that is parallel to the motor output axis, however does not drive an output member to reciprocate. The output member comprises a brush head having an axis that is angled 90° to the gear member axis.

USPN 5,822,821 to Sham discloses a housing, motor, a transmission allowing reciprocating rotary movement to drive a brush head, but does not disclose a second transmission or a section of internal gear.

USPN 5,974,615 to Schwartz-Hartmann et al. disclose a housing, motor, a transmission allowing reciprocating rotary movement to drive a brush head, but does not disclose a second transmission or a section of internal gear.

USPN 3,577,579 to Duve discloses a housing, motor, a transmission allowing reciprocating rotary movement to drive a brush head, but does not disclose a second transmission or a section of internal gear.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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LCC

14 October 2004

Robert J. Warden, Sr.
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